

REMARKS

A. BACKGROUND

The present Amendment is in response to the Office Action mailed March 29, 2010. Claims 24-46 were pending, claims 41-46 were previously withdrawn, and claims 24-40 were rejected in view of cited art. Claims 41-46 are cancelled, claims 24-25, 29, 31, and 33-34 are amended, and new claims 47-49 are added. Claims 24-40 and 47-49 are now pending in view of the above amendments, with claims 24 and 47 being independent.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, are consistent with the Examiner's understanding.

B. CLAIM OBJECTIONS

The Office Action objected to claims 41-46 and 29-34 because of certain informalities. Claims 41-46 were objected to because they depended from cancelled claims, while claims 29-34 were objected under 37 C.F.R. §1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim.

By this amendment claims 41-46 are canceled and claims 29, 31, 33, and 34 are amended to more clearly recite claimed structures. In view of the amendment, Applicant respectfully requests withdrawal of the objections to claims 29-34 and 41-46.

C. PRIOR ART REJECTIONS

I. REJECTION UNDER 35 U.S.C. §102(A)\(B)\(E)

As presented herein for reconsideration, the invention claimed in independent claim 24, as exemplary, comprises an apparatus for sealing a puncture tract disposed within tissue. The apparatus comprises a housing, an expandable member disposed through the housing, the expandable member being configured to be disposed within the puncture tract to stabilize the

tissue, and a plurality of needles coupled to the housing, the plurality of needles configured to penetrate tissue surrounding the puncture tract to deliver a closure agent into the tissue to thereby seal the puncture tract.

The Office Action rejected claims 24 and 27-35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,572,336 (Hershberg), while rejecting claims 24-26, 28-35, and 38-40 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,251,063 (Silverman). In addition, the Office Action rejected claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Hershberg as applied to claims 24 and 33, and further in view of U.S. Publication No. 2002/0143291 (Slater). Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverman as applied to claim 24, and further in view of U.S. Patent No. 6,835,193 (Epstein), while claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverman as applied to claims 24 and 33, and further in view of Slater.

Applicant respectfully submits that the independent claims as presented for reconsideration are not anticipated nor made obvious by Hershberg or Silverman either singly or in combination with any other cited reference of record.¹ In particular, Hershberg was cited as disclosing "a housing (10); a plurality of needles (24) coupled to the housing; a stop (bottom/base of the case 10) configured to limit transition of the plurality of needles" (Office Action, p. 3). The identified "stop" appears to be formed of the housing, i.e., the bottom/base of the case. Of note, Hershberg neither teaches nor suggests the inclusion of an expandable member.

Silverman was cited as disclosing "a housing (21); a plurality of needles (Fig. 14) coupled to the housing; an expandable member (211)" (Office Action, p. 3) and that the expandable member or "balloon assembly 211 has a first or lower balloon 212 sized for disposition below the lower esophageal sphincter 187 . . . Balloon assembly 211 has a second or upper balloon 213 . . . above the lower esophageal sphincter 187" (col. 8, ll. 56-62). "An opening 214 can be provided through upper balloon 213 for permitting insertion tube 31 [of the needle carrying probe 22] to extend through the balloon 213" (col. 8, ll. 62-64) (emphasis

¹ Any amendments to claims other than those which are expressly relied upon in overcoming the rejections on art have been made simply to insure consistency in claim language, to correct typographical or grammatical errors, or to correct other errors of a formal, non-substantive nature, but not to otherwise narrow the claims in scope for any reason.

added). As illustrated and described, therefore, Silverman discloses a balloon assembly, with the upper balloon having a lumen through which the insertion tube or housing of the probe passes.

In contrast to both Hershberg and Silverman, independent claims 24 and 47 recite, in part, “an expandable member disposed through the housing.” As mentioned above, Hershberg is silent to the inclusion of an expandable member, while the expandable member of Silverman receives the “insertion tube” or the insertion tube “extend[s] through the balloon 213”, which is opposite to the expandable member being “disposed through the housing” as recited in independent claim 24.

In addition to the above, and with reference to new independent claim 47, neither Hershberg nor Silverman include “an expandable member . . . including a stop configured to cooperate with the base.” As mentioned above, Hershberg neither teaches nor suggests the inclusion of an expandable member and with the “stop” of Hershberg identified as the “bottom/base of the case 10” it is not possible for the base to cooperate with itself. Turning to Silverman, it neither teaches nor suggests the inclusion of a stop, but rather was combined with Epstein which was cited for the proposition that it discloses “a stop (15 and 14) to limit transition of a needle into body tissue” (Office Action, p. 5). The “stop” of Epstein is included on the needle and “an electroconductive tip portion 35” of the “distal tip of the catheter body” (col. 8, ll. 34-35). Even if, *arguendo*, Silverman were combined with Epstein, the combination would still not teach or suggest the inclusion of “an expandable member . . . including a stop configured to cooperate with the base” because the combination would teach or suggest including a stop on the needle within the probe 22 rather than on the balloon, i.e., expandable member.

Accordingly, for at least the reasons noted, independent claims 24 and 47 and the claims depending therefrom² are neither anticipated nor made obvious by Hershberg and Silverman, either singly or in combination with any other cited prior art of record³, and thus reconsideration and withdrawal of the rejection is respectfully requested.

² Emphasis herein of the differences between the independent claims and the prior art are equally applicable to the dependent claims 25-40 and 48-49, but this does not mean, on the other hand, that these are necessarily the *only* differences between the claimed invention and the prior art of record. Applicants thus do not acquiesce in any asserted rejections of the dependent claims 25-40 and 48-49.

³ In addition to the above, Slater was cited as a secondary reference. Slater was cited for the proposition that it discloses “a radiopaque marker (58) disposed adjacent to the distal tip of a surgical insertion tool (26)” (Office Action, p. 6). That said, Slater does not otherwise add anything in terms of reading on the claims as amended herein, particularly in reference to those claimed limitations noted above which clearly define over Hershberg and/or Silverman. Thus, even assuming *arguendo* that Slater or Epstein is properly combinable with Hershberg and/or

D. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 29th day of June, 2010.

Respectfully submitted,

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